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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,755	07/15/2003	Lee W. Johnston	53394.000712	6941

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EXAMINER

CHAPMAN, GINGER T

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,755	<b>Applicant(s)</b> JOHNSTON ET AL.	
	<b>Examiner</b> Ginger T. Chapman	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 16-31 and 33-49 is/are pending in the application.
- 4a) Of the above claim(s) 30, 31 and 33-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13, 16-31 and 33-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 May 2006 has been entered.

### ***Status of the claims***

By way of Applicant's amendment filed 5 May 2006, claims 14, 15, 32 and 33 are cancelled; claims 1-13, 16-31 and 34-49 are pending in the application.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-29, drawn to absorbent article comprising a topsheet, backsheet, absorbent core disposed therebetween, classified in class 604, subclass 368.

Group II. Claims 30-49, drawn to a method of making an absorbent article comprising the steps of preparing a topsheet and backsheet, preparing an absorbent core and disposing an absorbent laminate core between the topsheet and backsheet, classified in class 604, subclass 358.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process of Group II can be used to make a bandage for wound covering.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. William Gosz on 7 August 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 30-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 and 16-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski (WO 99/49826) in view of Jackson (US 5,350,37).

With regard to claim 1: Chmielewski discloses an absorbent article (10) comprising: a topsheet (30); a backsheet (32), an absorbent core (342) disposed between the topsheet (30) and the backsheet (32), said core comprising core by dispersing superabsorbent polymer (SAP) within a fibrous matrix (page 22, lines 13-16); the absorbent core has a density within the range of from about 0.05 to about 0.45 g/cm<sup>3</sup> (page 6, lines 2-3).

Chmielewski discloses an absorbent article comprising a topsheet, a backsheet and an absorbent core disposed between the topsheet and the backsheet. Chmielewski does not expressly disclose the absorbent core having a basis weight within the range of from about 650 to about 1350 gsm. Jackson at column 7, lines 36-38, teaches the ability of the absorbent core basis weight to be tailored to a particular desired end use and thus expresses the desire and motivation to tailor the absorbent core basis weight to an intended use. Jackson teaches an absorbent core having a basis weight from 100-1000 gsm (col. 2, lines 63-64). In view of this known teaching, to form the absorbent core of Chmielewski having the basis weights as taught by Jackson would have been obvious to one of ordinary skill in the art at the time the invention was made since the provision of size adjustability involves only routine skill in the art.

With respect to a thermal resistance (clo) of less than about 1.7 watts/m m<sup>2</sup>, as measured in a Thermolabo apparatus, Chmielewski does not perform the claimed test on the absorbent structure and therefore does not disclose results for these tests. The absorbent structure of Chmielewski comprises the same structure and materials disclosed in the instant specification as being a suitable embodiment of the instant invention. Therefore the claimed test results are

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inherent to the material, and the absorbent structure of Chmielewski fulfills all limitations of the claim.

When the structure of the composition recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP § 2112-2112.01). A prima facie case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim, (in this case, an absorbent article comprising a topsheet, a backsheet, an absorbent core disposed between the topsheet and the backsheet) except for a property or function (in the present case, a thermal resistance (clo) of less than about 1.7 watts/m<sup>2</sup>) and the examiner reasonably believes that the reference inherently possesses properties that anticipate or render obvious the claimed invention and thus has a basis for shifting the burden of proof to applicant, as per *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Claim 2: Chmielewski discloses the topsheet (30) and the backsheet (32) form a first waist region (22), a second waist region (24) longitudinally opposite the first waist region, and a crotch region (26) there between, and the absorbent article further comprises at least one fastening element (40) attached to a lateral edge of the first waist region; and one or more target devices attached to the article in the second waist region, where at least one fastening element and the one or more target devices are capable of attaching to one another, the one or more target devices being located so that the first waist region and second waist region of the garment may be joined to one another to secure the garment on a wearer (page 20, lines 5-7 and lines 10-11).

Claim 3: Chmielewski discloses the elastic leg gathers (36) comprising one or more elastic materials disposed adjacent a lateral edge of the crotch region (page 19, lines 19-20), and

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standing leg gathers (501, 502) disposed on the topsheet adjacent a lateral edge of the crotch region (page 46, lines 19-21).

Claim 4: Chmielewski discloses the at least one fastening element comprises a hook portion of a hook and loop fastener and the one or more target devices comprise the loop portion of a hook and loop fastener (page 20, line 6 (401) and page 15, line 24-25).

Claim 5: Chmielewski discloses at least one fastening element is an adhesive tape (page 15, line 24) and the one or more target devices comprise a tape receiving surface.

Claim 6: Chmielewski discloses at least one fastening element is comprised of a pair of laterally extending tabs (page 20, line 6) disposed on the lateral edges of the first waist region, whereby the laterally extending tabs each include at least one fastening element.

Claim 7: Chmielewski discloses a fluid acquisition layer (fig. 6: (650); page 26, line 5-6) disposed between the topsheet and the backsheet.

Examiner notes that WO99/49826 page 23 lines 4-5 identify figure 6 (650) as a low density acquisition layer while page 23, line 14 identifies fig. 6 (650) as an optional transfer layer comprising layers 652 and 654. Examiner is interpreting (650) as an acquisition layer in light of p. 23 of WO99/49826, layer 652 as the absorbent layer in light of p. 26 line 9 and layer 654 as the wicking layer in light of p. 23 lines 14-18 and p. 26 lines 8-12.

Claim 8: Chmielewski discloses a distribution layer (page 11, lines 29-31 to p. 12, lines 1-2 and p. 25, lines 21-31: fig. 5b (342e)) disposed between the topsheet and the backsheet.

Claim 9: Chmielewski discloses a wicking layer (654) disposed between the topsheet and the backsheet. See claim 7, *supra*.

Claim 10: Chmielewski discloses a storage layer (p. 11, lines 21-22; p. 20, line 24: (342a)) disposed between the topsheet and the backsheet.

Claim 11: Chmielewski discloses a fragmented layer (page 23, lines 20-23) disposed between the topsheet and the backsheet. Examiner has interpreted “fragmented layer” in light of applicant specification: page 34 lines 19-22 describes fragment layer as fragments of other layers and p. 42 line 7 suggests fragmenting layers using guidelines provided therein. A thorough reading of applicant specification fails to reveal specific guidelines or further teachings of fragmenting the layer. In light of the physical description, examiner has interpreted fragmented layer as a layer having different combinations of materials.

Claim 12: Chmielewski discloses a combination of a wicking layer and a distribution layer (page 28, lines 29-31 to p. 29, lines 1-13; figs. 12a-12c) disposed between the topsheet and the backsheet.

Claim 13: Chmielewski discloses the absorbent core comprises: an upper layer (fig. 2: 342b); a lower layer (342c); and a central fibrous layer (342a) disposed between the upper layer and the lower layer, the central fibrous layer comprising a mixture of at least a fibrous material and superabsorbent polymer (SAP) (page 22, lines 13-16).

Claim 16: Chmielewski discloses wherein the SAP is selected from the group consisting of a water swellable polymer of water soluble acrylic or vinyl monomers crosslinked with a polyfunctional reactant, a starch modified polyacrylic acid, a hydrolyzed polyacrylonitrile, alkali metal salts of hydrolyzed polyacrylonitrile, and mixtures thereof (page 1, lines 21-27).

Claim 17: Chmielewski discloses the SAP is a starch grafted polyacrylate sodium salt (page 1, lines 26-28).



Claim 18: Chmielewski discloses the fibrous material is selected from the group consisting of a crimped tow of cellulose acetate or polyester, a low-density roll good, a carded web, and mixtures or combinations thereof (page 35, lines 16-20).

Claim 19: Chmielewski discloses the absorbent core further comprises from about 1-5% of a thermally bondable fiber (page 29, lines 27-28).

Claim 20: Chmielewski discloses the fibrous material is a crimped tow of cellulose acetate (page 35, line 17).

Claim 21: Chmielewski discloses the central fibrous layer comprises from about 50% to about 95% by weight super absorbent polymer (SAP), and has a SAP efficiency of at least 80% (page 9, lines 4-10).

Claim 22: Chmielewski discloses the central fibrous layer further comprises particulate additives (page 13, line 25).

Claim 23: Chmielewski discloses the particulate additives comprise insoluble, hydrophilic polymers having particle diameters of 100  $\mu\text{m}$  or less (page 14, line 3).

Claim 24: Chmielewski discloses the particulate additives are selected from the group consisting of potato, corn, wheat, and rice starches, and partially cooked or modified starches (page 14, lines 8-9).

Claims 25-28: With respect to intrinsic thermal resistance values, i.e., "Rcf values less of than about 0.25 degrees C  $\text{m}^2/\text{Watts}$  as measured on a 20x20 inch sample in a Thermolabo apparatus" and "less than about 0.17 degrees C  $\text{m}^2/\text{Watts}$  as measured on a 20x20 inch sample in a Thermolabo apparatus" and thermal resistance values, i.e., "clo values of less than bout 1.65 watts/ $\text{m}^2$ " and "less than about 1.40 watts/ $\text{m}^2$ ", Chmielewski does not perform the claimed tests

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on the absorbent structure and therefore does not disclose results for these tests. The absorbent structure of Chmielewski comprises the same structure and materials disclosed in the instant specification as being a suitable embodiment of the instant invention. Therefore the claimed test results are inherent to the material, and the absorbent structure of Chmielewski fulfills all limitations of the claim.

When the structure of the composition recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP § 2112-2112.01). A prima facie case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim, (in this case, an absorbent article comprising a topsheet, a backsheet, an absorbent core disposed between the topsheet and the backsheet) except for a property or function (in the present case, intrinsic thermal resistance and thermal resistance values,  $R_{cf}$  and  $clo$ ) and the examiner reasonably believes that the reference inherently possesses properties that anticipate or render obvious the claimed invention and thus has a basis for shifting the burden of proof to applicant, as per *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Claims 29: Chmielewski discloses the absorbent core has a thickness within the range of from about 5 to about 20 mm (fig. 7b).

### ***Response to Arguments***

Applicant's arguments filed 5 May 2006 have been fully considered but they are not persuasive. Applicant submits the following:

I. Chmielewski does not disclose an absorbent core with a thermal resistance of less than about 1.7 watts/m<sup>2</sup>, and the thermal resistance is a functional limitation that distinguishes the claimed invention over the prior art

II. Jackson teaches the claimed basis weight of the absorbent core, however it would not be obvious to combine Jackson with Chmielewski because Jackson contains no disclosure pertinent to the claimed thermal transmittance properties of the absorbent core structure and therefore there is no motivation to combine Chmielewski with Jackson.

III. Claims 15 and 33 are cancelled and the limitations of claims 15 and 33 are now inserted into independent claims 1 and 30.

These arguments are not persuasive for the following reasons:

I. The thermal resistance of an absorbent core is not a functional recitation but a property or characteristic of the material and structure comprising the core. Additionally, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference). Further, apparatus claims cover what a device *is*, not what a device *does*. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See MPEP § 2114.

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Further, examiner maintains that thermal resistance of a material or structure is not a functional recitation, but is an inherent characteristic or property. The Chmielewski article seems to be identical to the claimed article except that Chmielewski is silent as to the inherent characteristic of thermal resistance. The discovery of a previously unappreciated property of a prior art article does not render the article patentably new. Thus the claiming of a new function or unknown property which is inherently present in the Chmielewski article does not necessarily make the instant claims patentable. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

Finally, Applicants have not presented a valid side-by-side comparison between the claimed article and that disclosed by Chmielewski, wherein the only difference is the claimed thermal resistance property. The above rejections are made in the sense of *In re Fitzgerald*, thus the burden to show that the prior art article having the same composition and structure does not possess the claimed property is shifted to Applicants as per *In re Fitzgerald*, 205 USPQ 594 (CAFC).

II. In response to applicant's argument that Jackson does not disclose thermal resistance, something old does not become patentable upon the discovery of a new property. *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability

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when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). See MPEP §§ 2112.01, 2141.02 with regard to inherency.

III. In response to applicant's argument that the limitations of claims 15 and 33 are now inserted into independent claims 1 and 30, this argument is not persuasive because claims 1, 15, 30 and 33 were previously rejected, thus the claims as amended do not distinguish over the prior art of record and thus do not overcome the previous rejection as stated in the previous Office action.

### ***Conclusion***

This is a RCE of applicant's earlier Application No. 10/618,755. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571) 272-4934. The examiner can normally be reached on Monday through Friday 8:30 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ginger Chapman  
Examiner, Art Unit 3761  
08/09/06

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TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER

